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EXAMINER

CONNELLY CUSHWA, MICHELLE R

ART UNIT

PAPER NUMBER

2874

DATE MAILED: 07/30/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/085,178

Applicant(s)

WOLF ET AL.

Examiner

Michelle R. Connelly-Cushwa

Art Unit

2874

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-4 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 27 February 2002 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|--------------------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>2</u> . | 6) <input type="checkbox"/> Other: . |

DETAILED ACTION

Information Disclosure Statement

The prior art documents submitted by applicant in the Information Disclosure Statement filed on June 26, 2002 have all been considered and made of record (note the attached copy of form PTO-1449).

Drawings

Twenty-five (25) sheets of informal drawings were filed on February 27, 2002. The informal drawings filed in this application are acceptable for examination purposes. When the application is allowed, applicant will be required to submit new formal drawings.

The drawings are objected to because reference number 602, which designates the cut-away region in Figure 3, is pointing to the wrong place on the Figure. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

Specification

The disclosure is objected to because of the following informalities: "FIG. 8" on page 11, line 20, should be --FIG. 8A--; and there is no brief description of Figure 8B as required by 37 CFR 1.74 (see MPEP 608.01(f)).

Appropriate correction is required.

Claim Rejections - 35 USC § 102

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The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 and 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Shimizu (JP 05-055710 A).

Regarding claims 1 and 4; Figure 1 of Shimizu discloses an optical transmitter (semiconductor laser module) comprising:

- a planarized header (surface of 8);
- a semiconductor laser (1) mounted on a plane of the planarized header (8), wherein an axis of light (the light is directed from the laser, 1, towards the lens, 2) emitted from the laser (1) is parallel to the plane; and
- a temperature sensor (thermistor, 4) of the laser (1) located on the planarized header (8);
- wherein the temperature of the laser (1) is obtained from an output of the temperature sensor (4) without application of an offset to the output of the temperature sensor.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and

the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shimizu (JP 05-055710 A).

Regarding claims 2 and 3; Shimizu discloses all of the limitations of claims 2 and 3, except for the temperature sensor being within 2.5 mm or within 1 mm of the laser, respectively.

Applicant does not specify that placing the temperature sensor within 2.5 mm or within 1mm of the laser solves any stated problem or is for any particular purpose (see page 57, lines 1-16 of the present application), but only that "the temperature sensor is positioned as close as practical (e.g., less than several millimeters, such as 0.6mm) from the center of the laser".

One of ordinary skill in the art would have recognized that the closer the temperature sensor is to the laser, the more accurate the sensed temperature of the laser, since heat dissipates with distance. Therefore, It would have been obvious to one having ordinary skill in the art at the time the invention was made to place the temperature sensor within 2.5 mm or within 1 mm of the laser in the invention of Shimizu, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art (*In re Aller*, 105 USPQ 233) and Applicant has not disclosed that placing the temperature sensor within 2.5 mm or within 1 mm solves any stated problem or is for any particular purpose.

Conclusion

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

Odagiri (US 4,884,279) discloses an optical transmission apparatus in Figure 2, the apparatus including both a semiconductor laser unit (20) and a thermistor (30) located on the planar surface of a header (end plate, 34), wherein light (24r) emitted from the laser is in a plane parallel to the surface of the header; and

Sato et al. (US 4,338,577) discloses a semiconductor laser apparatus in Figure 9, the apparatus including both a semiconductor laser (104) and a temperature sensor (106) located on a planar header (end plate, 103), wherein light (L1, L2) emitted from the laser is in a plane parallel to the surface of the header.

Any inquiry concerning the merits of this communication should be directed to Examiner Michelle R. Connelly-Cushwa at telephone number (703) 305-5327. The examiner can normally be reached 9:00 AM to 7:00 PM, Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rodney B. Bovernick can be reached on 703-308-4819. The fax phone number for the organization where this application or proceeding is assigned is 703-308-7724.

Any inquiry of a general or clerical nature should be directed to the Technology Center 2800 receptionist at telephone number (703) 308-0956.

Michelle R. Connelly-Cushwa
Michelle R. Connelly-Cushwa
Patent Examiner
July 21, 2003